

REMARKS

Reconsideration and withdrawal of the rejections set forth in the Office Action dated 20 August 2003 are respectfully requested. A separate petition for a one-month extension of time accompanies this amendment.

I. Amendments

The present amendment amends the first paragraph of the specification to reflect the application number assigned to the identified application; amends claims 1, 8, 9, 16-20, 32, and 39; cancels claim 21; and adds new claims 44 and 45. Upon entry of this amendment, claims 1-20, 22, 23, 31-37, 39, 44, and 45 will remain in the application. The present amendment requires no additional claims fees beyond those already paid in this application.

The undersigned would like to note that many of the changes to the claims are merely cosmetic, non-narrowing changes intended to improve grammar or the like. For example, claims 8 and 9 have been amended to correct minor grammatical errors and claim 32 has been amended to refer to a "mounting point" instead of a "mount point" to improve consistency of terminology.

II. The Applied Art

All of the Examiner's rejections are based on a single reference, U.S. Patent 6,202,308 ("Ramun"). Ramun describes a large metal-cutting shear designed to be mounted on a backhoe. This large shear includes a series of inserts 10 that can be indexed to a particular position with respect to a fixed or moveable blade 34 or 38. These inserts 10 may be attached to one of the blades by one or more bolts 18, with a bolt 18 filling each of the holes in the insert. The bolts 18 are spaced equidistantly and the number of holes in an insert is tied only to its length. Hence, for an insert 10 that is too short to span two bolts, a single bolt is used. Ramun shows a longer insert that spans three bolts 18.

III. All Pending Claims Are Patentable Over the Applied Art

A. Claims 1-8

The Examiner summarily rejected claims 1-8, 16-23, 31-37, and 39 as anticipated by Ramun. The only explanation offered in support of the rejection was a characterization of the inserts 10 as “blades with cutting edges.” The undersigned respectfully submits that claim 1, at least as amended, patentably defines over Ramun.

Claim 1 calls for a cutting blade for a hand-held cutting tool configured to mount the cutting blade with first and second mounting rods that are spaced from one another by a mounting distance. The blade includes a body having spaced-apart first and second shear faces and at least three mounting holes passing through the body. A first pair of the mounting holes are spaced by the same mounting distance as the rods, as are a second pair of the mounting holes; at least one of the mounting holes in the second pair is not included in the first pair of mounting holes. A first shear edge is adapted to cooperate with a reciprocating cutting member to shear a workpiece when the first and second mounting rods are received in the first pair of mounting holes, and a second shear edge is adapted to cooperate with the reciprocating cutting member to shear the workpiece when the first and second mounting rods are received in the second pair of mounting holes. The first shear edge is spaced from the first pair of mounting holes by a fixed distance and in a fixed orientation with respect to the first pair and the second shear edge is spaced from the second pair of mounting holes by a fixed distance and in a fixed orientation with respect to the second pair.

The Examiner has not explained how he or she reads Ramun's disclosure as suggesting first and second pairs of mounting holes, with each pair bearing the stated relationship with a shear edge. If Examiner Watts believes Ramun teaches a cutting blade as defined in present claim 1, the undersigned requests that the Examiner explain how he reads Ramun so a more detailed response may be presented.

Claims 2-8 and 44 depend from claim 1. If claim 1 is patentable over Ramun, these claims are patentable because they depend from a patentable base claim. Many of these claims are also patentable in their own right, independently of the patentability of claim 1. Claim 44, for example, requires that the at least one mounting hole of the second pair that is not included in the first pair (as recited in claim 1) does not receive a mounting rod when the first and second mounting rods are received in the first pair of

mounting holes. The undersigned respectfully submits that nothing in Ramun would fairly suggest such a feature.

B. Claims 9-15

Claim 9 calls for a cutting blade having, among other features, a body and at least five mounting holes passing through the body and defining first, second, third and fourth pairs of mounting holes. At least one of the mounting holes of each of the first, second, third and fourth pairs of mounting holes being included in none of the other three pairs of mounting holes. Each of four spaced-apart shear edges is spaced a fixed distance from and in a fixed orientation from a corresponding one of the four pairs of mounting holes. Claim 9 also states that the blade can be reoriented to position one of the four shearing edges for cooperation with a reciprocating cutting member by attaching the blade using a corresponding one of the four pairs of mounting holes.

The Examiner acknowledges that Ramun does not teach the claimed arrangement of holes, but rejects claims 9-15 as obvious over Ramun viewed alone: "The number of holes, absent a showing of criticality, would appear to be a matter of obvious choice. Thus specifying 5 holes for the blades would have been obvious." The undersigned respectfully submits that this fails to state even a prima facie basis for a §103 rejection because the Examiner has neither cited any reference that suggests such a modification nor explained why anyone skilled in the art would be motivated to modify Ramun's disclosure to arrive at the claimed invention. Claim 9 and dependent claims 10-15

In addition to calling for at least five holes, claim 9 characterizes the interrelationship of these mounting holes with one another and with four shear edges. Hence, if the Examiner elects to maintain a rejection of claims 9-15 as obvious over Ramun, the Examiner must come forward with a reference that not only suggests modifying Ramun's inserts to include five holes, but also suggests mounting holes bearing the same relationship with each other and the shear edges called for in each of claims 9-15. The undersigned would also like to note that the minor change in claim 9 should not necessitate a new grounds of rejection and requests an opportunity to respond to any new grounds of rejection of claims 9-15 on a non-final basis.

C. Claims 16 and 17

As amended, claim 16 calls for two blades, each of which has a specific structure. The claim also specifies that a first shear face of one of these blades is parallel to and spaced from a third shear face of the other blade by a gap and that this gap is sized to movably receive a reciprocating cutting member. In contrast, it appears that the inserts 10 on one of Ramun's blades are designed to directly confront the inserts 10 on the other blade. Accordingly, claim 16 and dependent claim 17 are patentable over Ramun.

D. Claims 18-20, 22, and 23

Claim 18 calls for a cutting blade that includes a body; a first guide surface; parallel and spaced-apart first and second shear edges; and first and second pairs of mounting points. The first pair of mounting points is adapted to mate with the support of a housing to position the first shear edge adjacent a reciprocating cutting member for shearing a workpiece and to position the second shear edge transversely outwardly of both the reciprocating cutting member and the first shear edge. Analogously, the second pair of mounting points is adapted to mate with the support of the housing to position the second shear edge adjacent the reciprocating cutting member for shearing a workpiece and to position the first shear edge transversely outwardly of both the reciprocating cutting member and the second shear edge. The first pair of mounting points includes a central mounting point spaced a first distance from the first shear edge and a first distal mounting point spaced a second distance from the first shear edge. The second pair of mounting holes includes the central mounting point, which is spaced the first distance from the second shear edge, and a third distal mounting point spaced the second distance from the second shear edge. Dependent claims 19 and 20 recite specific relationships between the first and second distances.

The undersigned does not fully understand the Examiner's basis for rejecting prior claim 18 as anticipated by Ramun. Without conceding the merits of the Examiner's prior position, the undersigned fails to see how Ramun can be fairly said to anticipate the invention of amended claim 18. In the absence of any motivation to modify Ramun to arrive at the structure of claim 18, this claim must also be deemed unobvious over Ramun. Claims 19, 20, 22, and 23 depend from claim 18 and are

believed to be patentable at least by virtue of their dependence from a patentable base claim.

E. Claims 31-36 and 45

Claim 31 defines a cutting blade that includes, *inter alia*, a body having first, second, third, and fourth shear edges and first, second, third, and fourth pairs of mounting points. Each of the four shear edges is associated with a corresponding one of the four pairs of mounting points and each pair of mounting points includes first and second mounting points spaced the same fixed distance from one another. The Examiner has rejected this claim as anticipated by Ramun, but the undersigned fails to see anything in Ramun even suggesting, much less explicitly teaching, a cutting blade including four pairs of mounting points associated with a corresponding one of four shear edges. Accordingly, it appears that claim 31 and dependent claims 32-36 and 45 are patentable over Ramun.

If the Examiner elects to maintain this rejection, the undersigned requests that the Examiner provide a more detailed explanation of the basis for rejection, including an indication of which elements in Ramun comprises each of the four shear edges and each of the four pairs of mounting points recited in claim 31. The undersigned would also like to call the Examiner's attention to new claim 45, which more particularly characterizes the pairs of mounting points.

F. Claim 37

Claim 37 calls for a cutting blade that includes a body having, among other features, at least six mounting holes that define first, second, third, and fourth pairs of mounting holes. Claim 37 also requires that the second pair include at least one mounting hole not in the first pair; that the third pair include at least one mounting hole that is included in neither the first pair nor the second pair; and that the fourth pair include at least one mounting hole that is included in none of the first pair, the second pair and the third pair.

In rejecting claim claims 9-15, the Examiner acknowledged that Ramun failed to teach an insert with at least five holes. The undersigned simply cannot see, therefore, how the Examiner can contend Ramun teaches an insert having at least six mounting holes, as called for by claim 37. As Ramun neither teaches nor suggests the structure

of claim 37, the undersigned respectfully submits that claim 37 is patentable over Ramun.

G. Claim 39

Without conceding the merits of the Examiner's rejection of claim 39 as anticipated by Ramun, the undersigned has amended claim 39 to highlight a relationship between the first and second blades. In particular, the first mount of the second blade is adapted to position the second blade's first shear edge adjacent a reciprocating cutting member and parallel to one of the first and second shear edges of the first blade for shearing a workpiece. Similarly, the second mount is adapted to position the second blade's second shear edge adjacent the reciprocating cutting member and parallel to one of the first and second shear edges of the first blade for shearing a workpiece.

Ramun does not appear to employ a pair of inserts that can be mounted in this fashion. Consequently, claim 39 is distinguishable from Ramun. As the undersigned sees nothing in Ramun that would suggest modifying the illustrated structure to arrive at the structure of claim 39, claim 39 is unobvious over Ramun, as well.

IV. Conclusion

In view of the foregoing, the claims pending in the application comply with the requirements of 35 U.S.C. § 112 and patentably define over the applied art. A Notice of Allowance is, therefore, respectfully requested. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-3848.

Respectfully submitted,

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